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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/658,736      | 09/11/2000  | James M. Zavislan    | ML-0414DIV          | 3878             |

7590 09/23/2003  
Kenneth J LuKacher  
South Winton Court  
Suite 304  
3136 Winton Road South  
Rochester, NY 14623

EXAMINER

SMITH, RUTH S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3737

8

DATE MAILED: 09/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,736

Applicant(s)

ZAVISLAN, JAMES M.

Examiner

Ruth S Smith

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8, 19-23 and 26-41 is/are pending in the application.
- 4a) Of the above claim(s) 38-41 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20-23 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 8, 19 and 26-37 is/are rejected.
- 7) ☒ Claim(s) 3-5 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Election/Restrictions***

Claims 38-41 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention; there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2,8,19,26-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Dhawan. The claims are directly readable on Dhawan which discloses a system for examining tissue by maintaining the tissue under stress and examining the tissue under stress with a confocal imaging camera. The means for maintaining the tissue under stress includes a platen 54 and suction means which applies a force against at least the edges of the area of skin tissue being imaged. The opening in the platen 54 includes a material window as part of element 44. Placement of the platen with respect to the tissue to be imaged inherently includes the means for moving it into position as set forth in claim 2.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,20,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dhawan in view of Jester et al, "In Vivo, Real-time Confocal Imaging". Dhawan

Art Unit: 3737

discloses a system for examining tissue by maintaining the tissue under stress and examining the tissue under stress with a confocal imaging camera. The means for maintaining the tissue under stress includes a platen 54 and suction means which applies a force against at least the edges of the area of skin tissue being imaged. The opening in the platen 54 includes a material window as part of element 44. Jester et al disclose means for fixing the position of the imaging device with respect to an area of the patient before it is lowered into place on the patient. It would have been obvious to one skilled in the art to have modified Dhawan such that it includes means for temporarily fixing the imaging with respect to the patient before it is moved into contact with the tissue. Such a modification allows for more precise positioning and handling of the device. Dhawan discloses means for moving the imaging head with respect to the orifice in that the camera can be inserted into the device. In the absence of any showing of unexpected results, the means used to move the head would have been an obvious design choice to one skilled in the art.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dhawan. Dhawan discloses a system for examining tissue by maintaining the tissue under stress and examining the tissue under stress with a confocal imaging camera. The means for maintaining the tissue under stress includes a platen 54 and suction means which applies a force against at least the edges of the area of skin tissue being imaged. The opening in the platen 54 includes a material window as part of element 44. Dhawan discloses means for moving the imaging head with respect to the orifice in that the camera can be inserted into the device. In the absence of any showing of unexpected results, the means used to move the head would have been an obvious design choice to one skilled in the art.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,19,26,29-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,2,7,20,22,23,28,29-34 of U.S. Patent No. 6,424,852. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application are an obvious broadening of the patented claims.

### ***Allowable Subject Matter***

Claims 4-5, 7,21-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth S Smith whose telephone number is (703) 308-3063. The examiner can normally be reached on M-F 5:30 AM- 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on (703) 308-2262. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 3737

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

A handwritten signature in black ink, appearing to read "Ruth S. Smith". The signature is fluid and cursive, with the first name "Ruth" being more prominent than the last name "Smith".

Ruth S Smith  
Primary Examiner  
Art Unit 3737

RSS